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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 958

H. C. BAXTER & BRO. AND
GENERAL FOODS CORPORATION, *Petitioners,*

v.

THE GREAT ATLANTIC & PACIFIC TEA COMPANY, INC.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

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Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit, entered in the above-entitled case on October 29, 1965.

CITATIONS TO OPINIONS BELOW

The opinion of the District Court* is reported in 236 F. Supp. 601, 144 U.S.P.Q. 74 (D. Me. 1965). The opinion of the Court of Appeals (App. B 20-21) is reported in 352 F.2d 87, 147 U.S.P.Q. 233 (1 Cir. 1965).

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* Printed in full in Appendix A to this petition, pp. 16-17, *infra*. Hereinafter references will be in the form: App. A followed by a page number.

JURISDICTION

The judgment of the Court of Appeals (App. B 19) was entered on October 29, 1965. No rehearing was sought. The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254(1).

QUESTIONS PRESENTED

Question 1. Whether the discovery of a new, useful, and unpredictable result in the adaptation of an old process to a new use is a patentable "discovery" within the meaning of Title 35, United States Code, sections 100 and 103?**

Question 2. Whether the claims of a patent, and particularly those of the patent here, in suit can, as a matter of law, be "invalid under 35 U.S.C., § 112 (App. A 18) because of the extent of experimentation required of one skilled in the art in order to understand their 'teaching' [sic]"?

The quoted statement in "Question 2" is the entire ruling of law of the Court of Appeals for the First Circuit in disposing of this case. We have quoted it *verbatim* from the Opinion below (App. B 20-21) because it is not understood by petitioners and appears to be totally incompatible with any *facts* actually found by the District Court.

STATEMENT

This is a suit for infringement of United States Letters Patent No. 2,498,024 brought by the patent owner, H. C. Baxter and Bro., a Maine partnership, and its licensee, General Foods Corporation, against an alleged infringer, The Great Atlantic & Pacific Tea Company, Inc. The patent (PR 323-325) is entitled "Prefrying Treatment of Potatoes. It

** References to the Record herein will be in the form: "PR" followed by page number to cite the printed Record Appendix of Petitioner in the Court of Appeals; "RR" to cite to that of Respondent.

has for its object the industrial production of French fried potatoes for quick freezing now produced at an annual rate of about a billion pounds in the United States. The industry requires these potatoes to be fried to a quite rigidly uniform color though the raw potatoes used are of varying sugar content and would therefore fry to varying colors if untreated. The patented process solves this dilemma.

The defendant for some years purchased its frozen French fried potatoes from the patentee, but in 1961 began its own production. The process employed is described in an agreed statement (PR 335-344). The described process is alleged by plaintiffs to be effectively the same as the patented process.

The usual defenses of invalidity for lack of invention and non-infringement were pleaded, as was also, belatedly, invalidity on the ground that the patent specification did not comply with the requirements of 35 U.S.C. § 112 (App. A 18). It was this last defense that seems to have been upheld by the District Court by its judgment (App. B 22) and opinion (App. B 24-50). No decision was made by the District Court as to the other alleged grounds of invalidity or on the issue of infringement.

An appeal was taken to the Court of Appeals for the First Circuit, where plaintiffs again sought a ruling on the issues of infringement and the other pleaded grounds of invalidity. The Court of Appeals, however, affirmed the District Court with a judgment (App. B 19) and "Per Curiam" opinion (App. B 20-21). The action of the Court of Appeals appears meaningless to petitioners and it made no ruling whatsoever on other issues not decided below.

The Patented Process

As described in the patent specifications, the claimed invention "relates to the treatment of raw or cooked potato particles and particularly to such particles in the form of

strips for French frying, in order to secure a desired and substantially uniform change in their color when they have been suitably cooked by frying." (*Pat. Col. 1, lines 1-6). The specifications recite that in the frying of potatoes on a commercial basis, it is important that they be suitably browned when fried; and whether suitable browning can be attained depends on their sugar content (Pat. Col. 1, lines 7-11). Where the sugar content of the potatoes is low, as is the case when the potatotes are freshly dug, the potato particles do not change color sufficiently when cooked by frying. On the other hand, if the sugar content of the potatoes is high, the particles when suitably fried are too dark because of the caramelization of the sugar.** (Pat. Col. 1, lines 12-26). While the sugar content of potatoes may be governed to some extent through a control of storage temperatures,*** the expense of controlling storage conditions is substantial (Pat. Col. 1, lines 29-37). The alleged invention purports to minimize the problem "by treating raw or cooked potato particles to establish, at least in the surface layer of the particles, a sugar content such that when the particles are suitably cooked by frying, the desired color change will result with substantial uniformity." (Pat. Col. 1, lines 40-46). This result is stated to be accomplished by immersing the particles in a solution of a sugar that may be absorbed by the particles and then cooking them by frying in a suitable medium, the characteristics of the solution, the time of immersion, and the frying time and temperature being so related to each other and to the natural sugar content of the particles that the desired

* References to "Pat." are to the patent in suit reproduced at PR 323 and to the numbered columns and lines thereof.

** As the record shows, caramelization is the degradation or breakdown of the sugar molecules by heat—what a layman would describe as burning.

*** Under normal storage conditions potatoes will acquire a relatively high sugar content. If the storage temperatures are relatively high, however, the content of the potatoes will be low. Generally, the lower the storage temperature, the higher the sugar content; the higher the storage temperature, the lower the sugar content. (Pat. Col. 3, lines 28-35).

color change is attained upon frying (Pat. Col. 1, line 46—Col. 2, line 6). In the patentee's own words,

> Where the natural sugar content is low, the treatment adds sugar to supplement any natural sugar that may be present in the particles. Where the natural sugar content is high but capable of being corrected by leaching, I dip the particles in a hot sugar solution so that at the completion of the leaching step a final sugar content is established that ensures that the desired color is secured when the particles are fried. Where the natural sugar content of some of the potatoes is high and too low in others, the hot sugar solution has a combination effect establishing and maintaining substantial uniformity of sugar content by a limited leaching action on the particles having excessive natural sugar and supplementing any natural sugar in particles having a sugar deficiency. (Pat. Col. 2 lines 7-23).

The patent specifications recite that while the sugar content of the potato particles may be determined by any suitable means, this may be done with sufficient accuracy for the purposes of the invention by frying samples under the conditions to be used in frying the particular batch of potatoes and comparing the color of the thus fried samples with a color chart showing the sugar content by color preestablished by frying various samples under uniform conditions of time and temperature. (Pat. Col. 2, lines 24-41).

The specifications further state that the primary requirement of the sugar is that it be readily absorbed by the potato particles. (Pat. Col. 3, lines 51-52). Suitable sugars are specified to be, in the class of monosaccharides, dextrose, fructose and galactose; in the class of disaccharides, sucrose, lactose and maltose; and raffinose, a trisaccharide. (Pat. Col. 3, lines 53-56). The patent states that while any of these sugars may be used, dextrose "is perhaps best suited for the practices of . . . [the] invention under commercial conditions." (Pat. Col. 3, lines 57-60). The sugar